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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,035	10/24/2003	James K. Sankey	1007-NO-CONT	1756

27542 7590 08/23/2004

SAND & SEBOLT
AEGIS TOWER, SUITE 1100
4940 MUNSON STREET, NW
CANTON, OH 44718-3615

EXAMINER

FOSTER, JIMMY G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,035

Applicant(s)

SANKEY ET AL.

Examiner

Jimmy G Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01 December 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This application is a continuation of application serial No. 904,264 and therefore may not include new matter over the original disclosure of the parent application. The limitation in line 12 of present claim 1, regarding the sidewall being rigid is not supported by the original disclosure of the parent application and therefore constitutes new matter. While the claimed terms "unmovable" and "fixed," and the meanings of those terms, are considered to be supported by the parent disclosure, either expressly or inherently, the term "rigid" in describing the side wall is not supported. The examiner contends that the term "rigid" can have a different meaning than the term "unmovable."

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1, 7-9 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Wong et al (6,283,280). The hub of Wong et al is readable on Applicant's claimed hub, insofar as claimed, and may be considered to include the combination of the tube portion 2 and the locking knob portion 4. A continuous vertical sidewall (unnumbered) of the knob portion 4 includes outwardly extending flexible/elastic locking fingers/wings 44 which have a height less than the height of said sidewall. The wall may be said to be continuous since it continuously extends around the periphery of the knob portion of the hub. When the knob 4 is locked/tightened onto the tube 2, as described in column 3, lines 18-33, said vertical sidewall of knob 4 may be said to be fixed and rigid with respect to the base 21. Regarding applicant's claim 9, insofar as Applicant has claimed, the sidewall of the knob 4 of the hub may be said to be unmovable with respect to the key element 32, and therefore Applicant's claim 9 does not distinguish over Wong et al.

In addition the device of Wong et al includes a base at 11 and a lid as shown in Figures 1 and 2.

It is possible to make a disc-shaped item of recording media with a central opening that is not circular. Moreover, there is no definitional or functional requirement that a disc-shaped item of recording media have a circular shape for its central opening. Inasmuch as Applicant has not positively recited the media and characteristics thereof as structure in the claims, the examiner asserts that the flexibility of the flexible finger 44 of Wong et al makes the finger inherently capable of flexed so as to permit an appropriately sized and shaped opening of a disc-shaped media to be forced

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down over the hub 2,4, with the finger 44 becoming disposed on top of the disc-shaped media.

4. Claims 1, 7-9, 16, 8 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Brien et al (5,819,926). Figures 4, 7 and 8 of O'Brien show a hub at central core 22 which is attached to a base (20,32), wherein the hub includes a sidewall (e.g. at 42) that is unmovable, fixed and rigid, as indicated from a contrast of Figures 7 and 8, and wherein the hub includes plural integral flexible fingers 38 attached to the sidewall 24. The hub will retain a disc-shaped media item 50 in a seating area of the base, as indicated in Figure 4.

Inasmuch as the side wall extends from the base to the top of the hub, it may be considered to be continuous, insofar as Applicant has claimed.

Additionally, there is provided a lid 16 which closes on the base and the seating area of the disc-shaped item (col. 6, lines 25-28).

Although the reference shows the flexible fingers as remaining bent and within the opening of the disc-shaped media during disc retention, instead of being disposed over the top of the disc-shaped media, Applicant does not positively recite the disc-shaped media in the claims as structure but as intended use. Inasmuch as the fingers 38 of the O'Brien et al reference are capable of being disposed over a disc-shaped media item which is thinner than the gap between the bottom of the finger shown in Figure 8 and the top surface of the portion 32 of the base 30,32 (since the thinner disc-shape would be able to move past the ends of the fingers), what Applicant has claimed regarding forcing the media down over the hub until the fingers are

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disposed over the media, does not distinguish over the subject matter of O'Brien et al.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-6, 10-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien et al (5,819,926) in view of Dean (6,123,191). Although the reference of O'Brien et al does not disclose the fingers 38 as becoming disposed over the top of the disc-shaped media, the reference of Dean, at 34 and along with the paragraph regarding operation at column 3, lines 1-22, suggests that the integral flexible peripheral portion (34) of a hub for engaging the opening in a disc-shaped media may be located closer to the top of the sidewall of the unmovable post portion of the hub, for the purpose of providing a sufficiently high location on the side wall to permit the disc-shaped media to be captured under the flexible portion. Disposal of the flexible portion (34) over the top of the disc-shaped item would provide blocking interference between the disc-shaped item and the flexible portion (34), thereby preventing inadvertent removal of the disc-shaped item from the base (20). Accordingly, it would have been obvious in view of Dean to have located the flexible portions/fingers 38 of O'Brien et al at the top of the sidewall 22,42 so as to permit the disc-shaped item to fully move past the

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fingers and permit the fingers to provide blocking interference against inadvertent removal of the disc-shaped item 50.

In addition, the reference of Dean suggests that the sidewall of a hub may have a continuous cylindrical shape. As apparent in Figures 4 and 8 of Dean, the cylindrical shape of the side wall avoids acting as a wedge against the inner edge of the central opening of the disc-shaped media item and therefore will not interfere with installing the disc on the hub under the flexible portion (34). Accordingly, the reference of Dean suggests that the continuous cylindrical shape of the side wall of a hub is a suitable shape when the disc-shaped media item is to be captured beneath a flexible bending portion (34) on the hub. Therefore, for these reasons, it would have further been obvious in view of Dean to have made sidewall (42 etc.) of the hub of O'Brien et al, as modified above, cylindrical in shape.

Although the reference of Dean as applied to O'Brien et al does not disclose making a flexible portion (34) of a hub (30) with an upper surface that is coplanar with respect to the upper surface of the sidewall of the hub (30), Applicant has not disclosed a reason for the particular configuration, and the examiner does not see a difference in function of a coplanar upper surface over an upper surface that is not coplanar. Inasmuch as a mere change in shape is generally recognized as being within the level of ordinary skill in the art (See In re Dailey et al., 149 USPQ 47; See also In re Seid, 73 USPQ 431), it would have been obvious to have made the fingers of O'Brien et al, as modified in view of Dean above, with any workable particular shape, including that as claimed by Applicant, which will capture the disc-shaped media in the manner as taught by Dean.

In addition, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re*

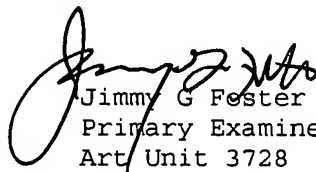
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Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). The general conditions regarding the sidewall and the locking finger of Applicant's claims are met by the teachings of O'Brien et al and Dean. Accordingly, it would have been obvious to have discovered desirable values or ranges, such as claimed, for the heights of the sidewall and the locking finger.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (703) 308-1505. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Jimmy G Foster
Primary Examiner
Art Unit 3728

JGF
20 August 2004